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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/606,522	06/26/2003	Matti Jokimies	200-008830-US (C01)	5739
2512	7590	12/08/2004	EXAMINER	
PERMAN & GREEN 425 POST ROAD FAIRFIELD, CT 06824			PEREZ GUTIERREZ, RAFAEL	
			ART UNIT	PAPER NUMBER
			2686	

DATE MAILED: 12/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/606,522

Applicant(s)

Jokimies et al.

Examiner

Rafael Perez-Gutierrez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 22-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 June 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. 09/370,661.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>6/26/03</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Priority

1. Acknowledgment is made of Applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. 09/370,661, filed on August 6, 1999.
2. Applicant has complied with the conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120.

Information Disclosure Statement

3. The information disclosure statement submitted on June 26, 2003 has been considered by the Examiner and made of record in the application file.

Preliminary Amendment

4. The present Office Action is based upon the original patent application filed on June 26, 2003 as modified by the preliminary amendment also filed on June 26, 2003. **Claims 22-27** are now pending in the present application.

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Specification

5. The amended abstract of the disclosure does not commence on a separate sheet in accordance with 37 CFR 1.52(b)(4). A new abstract of the disclosure is required and must be presented on a separate sheet, apart from any other text.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office Action:

A person shall be entitled to a patent unless -- (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 22, 23, and 25 are rejected under 35 U.S.C. 102(e) as being anticipated by **Mangold et al. (U.S. Patent # 5,926,232)**.

Consider **claims 22 and 23**, Mangold et al. clearly show and disclose a portable radio communication apparatus (mobile terminal) comprising an apparatus for controlling (control means) the encoding of a digital video signal encoded by a digital video codec (combination of source encoder 3 and channel encoder 4) (figure 1) and transmitted as a radio frequency communication signal by a second radio communication device to said portable radio communication apparatus (mobile terminal), said radio communication signal being received at said portable radio communication apparatus (mobile terminal) (abstract, figure 1, column 1 lines

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52-67, and column 3 lines 6-21), said apparatus for controlling (control means) comprising:

a channel decoder 7 (means for monitoring) (figure 1) for monitoring at least one parameter (e.g., a signal quality parameter) indicative of a property of the radio communication signal received at the portable radio communication apparatus (mobile terminal) (column 3 lines 43-45); and

means for forming (combination of multiplexer 12, telecommunications network 1, demultiplexer 13, and processor 14) (figure 1) for forming a signal responsive to said at least one monitored parameter (e.g., the signal quality parameter) for controlling at least one output (coding) parameter of the digital video codec (combination of source encoder 3 and channel encoder 4) (abstract, figure 1, column 1 line 34 - column 2 line 9, and column 3 lines 43-62).

Consider **claim 25**, Mangold et al. clearly show and disclose a portable radio communication apparatus (mobile terminal) comprising an apparatus for controlling (control means) the encoding of a digital video signal encoded by a digital video codec (combination of source encoder 3 and channel encoder 4) (figure 1) and transmitted as a radio frequency communication signal by said portable radio communication apparatus (mobile terminal), said radio communication signal being received by a second radio communication device (abstract, figure 1, column 1 lines 52-67, and column 3 lines 6-21), said apparatus for controlling (control means) comprising:

a channel decoder 7 (means for monitoring) (figure 1) for monitoring at least one parameter (e.g., a signal quality parameter) indicative of a property of the radio communication signal transmitted from the portable radio communication apparatus (mobile terminal) (column 3

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lines 43-45); and

means for forming (combination of multiplexer 12, telecommunications network 1, demultiplexer 13, and processor 14) (figure 1) for forming a feedback signal responsive to said at least one monitored parameter (e.g., the signal quality parameter) for controlling at least one output (coding) parameter of the digital video codec (combination of source encoder 3 and channel encoder 4) (abstract, figure 1, column 1 line 34 - column 2 line 9, and column 3 lines 43-62).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office Action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the Examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the Examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. **Claims 24, 26, and 27** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Mangold et al. (U.S. Patent # 5,926,232)** in view of well known prior art (MPEP 2144.03).

Consider **claims 24, 26, and 27**, and as applied to **claims 22 and 25** above, Mangold et al. clearly disclose the claimed invention except that the monitored parameter can also be the received signal strength, the transmission power, or the received power control command.

Nonetheless, the Examiner takes Official Notice that it is notoriously well known in the art to monitor, among other parameters, the transmission power, the received power control command, and the received signal strength of a radio communication signal for purposes of, for example, error correction, quality control, power control, and interference prevention.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the teachings of Mangold et al. with notoriously well known teachings in the art in order to include, as part of the parameters to be monitored, the transmission power, the received power control command, and the received signal strength of the communication signal for the purposes of error correction, quality control, power control, and

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interference prevention.

Double Patenting

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. **Claims 22-27** are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over **claims 1, 7, 8, 31-36, and 50-52** of U.S. Patent No.

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6,611,674 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 22-27 are essentially a broader version of patented claims 1, 7, 8, 31-36, and 50-52. Therefore, since omission of an element and its function in a combination is an obvious expedient if the remaining elements perform the same functions as before (*In re Karlson* (CCPA) 136 USPQ 184 (1963)), claims 22-27 are not patentably distinct from claims 1, 7, 8, 31-36, and 50-52.

Conclusion

11. Any response to this Office Action should be **faxed to (703) 872-9306 or mailed to:**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Hand-delivered responses should be brought to

220 S. 20th St.
Crystal Plaza Two, Lobby, Room 1B03
Arlington, VA 22202

12. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Rafael Perez-Gutierrez whose telephone number is (703) 308-8996. The Examiner can normally be reached on Monday-Thursday from 6:30am to 5:00pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's

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supervisor, Marsha D. Banks-Harold can be reached on (703) 305-4379. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700 or call customer service at (703) 306-0377.


Rafael Perez-Gutierrez
R.P.G./rpg **RAFAEL PEREZ-GUTIERREZ**
PATENT EXAMINER

December 6, 2004